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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,693	10/27/2003	Satoshi Idemura	031249	8680

23850 7590 12/27/2005

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/693,693	IDEMURA ET AL.	
	Examiner	Art Unit	
	Robert Sellers	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/27/03 & 3/1/04</u> | 6) <input type="checkbox"/> Other: _____ |

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Claims 4 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 2, 2005.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 12650 (Japanese '650).

1. Japanese '650 (CAPLUS abstract) shows a composition comprising an epoxy resin such as a dicyclopentadiene epoxy resin within the realm of claim 6 (translation, page 4, paragraph 36, lines 12, 13 and 16) and an aromatic polyester derived from isophthalic acid and a phenolic group-containing aromatic compound such as phenol, cresol, xlenol or naphthols (a suitable reactant as described on page 22 of the specification, structures c'-1 to c'-5, c'-11 and c'-12). The aromatic polyester is produced by either by an acetic anhydride method (page 6, paragraph 60) or an interface method (page 6, paragraph 61) which is equivalent to the ester exchange reaction and Schotten-Baumann reaction disclosed on page 15, line 23 to page 16, line 4 of the specification.

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2. The aromatic polyester of Japanese '650 in such species as the naphthol isophthlates or trimellitate set forth in the CAPLUS abstract (page 2, last IT) and represented by registry nos. 387336-23-4, 387336-24-5, 387336-25-6 and 387336-26-7 yield structures wherein the aromatic dicarboxylic is reacted with the naphthol at each carboxyl group to generate terminal aryloxycarbonyl groups as claimed.

3. Based on the equivalent aromatic dicarboxylic acid and phenol group-containing aromatic compound used to obtain equivalent aryloxycarbonyl-terminated polyester of the prior art and claims, the aromatic polyester of Japanese '650 inherently possesses the inherent viscosity of from 0.02 to 0.42 dl/g denoted in claim 2.

4. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Neither the closest prior art of Japanese '650 nor any of the other cited prior art recites either aromatic reactant (a) or (b) containing a benzene ring bonded to another benzene ring via a condensed polycyclic hydrocarbon.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. Japanese Patent Nos. 63-295620 and 5-51517 set forth epoxy resin formulations containing aromatic polyesters without the claimed aryloxycarbonyl terminal moieties.

6. Japanese Patent No. 54-124057 espouses an aryl ester-terminated polyester with an OH-containing polyester without the claimed epoxy resin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712